

REMARKS

By the present amendment, claims 1 and 17 have been amended to obviate the examiner's objections thereto and/or to further clarify the concepts of the present invention. In particular, independent claims 1 and 17 have been amended to replace the term "longer" with the term "longest" in order to address a rejection under the second paragraph of 35 USC § 112. Entry of these amendments is respectfully requested.

In the Office Action, claims 1-11 and 17-20 were rejected under the second paragraph of 35 USC § 112 as being indefinite. In particular, three primary points of alleged indefiniteness were identified:

- (A) the term "longer" lacked sufficient definition in terms of what the length is related to,
- (B) the recitation in claim 17 of "placing .... and vibrating and/or agitating...so as to form.." had insufficient structure; and
- (C) the specific conditions necessary to accomplish the recitation of "sufficient to form said film layer on the metal surface of said magnet" should be specified.

Reconsideration of this rejection in view of the above claim amendments and the

following comments is respectfully requested.

In response to portion (A) of this rejection, it is submitted that claims 1 and 17 have been amended to clarify the recitation by changing the term "longer" to "longest" thereby defining the recited range as being applicable to the largest dimension of the particle.

As to portions (B) and (C), it is noted that these portions are the same as was asserted in the prior Office Action. As to portion (B), this reasons for this rejection still are not understood as it is submitted that the noted recitation is not indefinite and sufficient structure is recited. The claim recites the step of "placing" (1) a rare earth metal-based permanent magnet and (2) a fine metal powder producing material into a treating vessel, and thereafter the step of "vibrating and/or agitating" both of (1) and (2) in said treating vessel. If it is not agreed that such recitations are sufficiently definite, further clarification is requested.

As to portion (C), it submitted that the inclusion of the noted recitation in the claim is not necessary. It is not the function of the claims to teach a person of ordinary skill in the art the manner of practicing the invention, rather it is the function of the specification to include such teachings as to specific conditions necessary to accomplish forming the film layer on the metal surface of the magnet.

For the reasons set forth above, withdrawal of the rejection under the second paragraph of 35 U.S.C. § 112 is respectfully requested.

Claims 1-3, 5-8 and 17-20 were rejected under 35 USC § 103(a) as being unpatentable over the patent to Mita et al in view of the Japanese patent publication to Yoshimura et al. In making the rejection of independent claims 1 and 17, it was asserted that the Mita et al patent teaches the claimed magnet except for the recited property of thickness of the film layer. The Yoshimura et al publication then was cited for teaching a film layer on a permanent magnet being relatively thin. Reconsideration of this rejection in view of the following comments is respectfully requested.

It is submitted that the patent to Mita et al does not teach or suggest the presently claimed invention for the reasons set forth in the prior response. Among other things, the Mita et al publication does not teach or suggest a film layer made of a fine metal powder formed on a metal surface of the magnet. Further, the Mita et al publication does not teach or suggest a film layer made of a fine metal powder of particles having a longest diameter in a range of 0.001  $\mu\text{m}$  to 5  $\mu\text{m}$ .

These above arguments were responded to in the subject Action. Specifically, it was asserted that the Mita et al patent teaches forming a layer on the magnet, citing lines 20-30 of column 16 thereof. As set forth previously, this characterization of the patent

teachings in the Action is not entirely accurate. The cited portion at column 16 of the Mita et al patent, while apparently teaching the formation of a metal layer on a permanent magnet, does not teach forming the layer from a "fine metal powder." Thus, it is submitted that the rejection as stated in the Action is based on a misstatement of the teachings of the cited patent.

Thus, in summary, it is submitted that the rejection as stated in the Action can be argued on the above basis that the Mita et al patent does not teach that which is being claimed. That is, the patent does not teach a film layer "made of fine metal powder" and where "particles of the fine metal powder having a longest diameter in a range of 0.001  $\mu\text{m}$  to 5  $\mu\text{m}$ . In response, it was asserted in the Action that applicants have not shown any specific advantage for the use of the fine metal powder as claimed. In this regard, attention is directed to lines 13-24 of page 6 and from line 6 of page 29 to line 30 of page 30 of the specification which set forth advantages and/or benefits of using the fine metal powder as claimed which is strong evidence of the non-obviousness of the claimed subject matter.

Additionally, it is to be noted that the subject independent claims recite that particles of a fine metal powder forming the film layer on a metal surface of the magnet have a longest diameter in a range of 0.001  $\mu\text{m}$  to 5  $\mu\text{m}$ . It is submitted that the patent to Mita et al does not teach or suggest such a film layer of fine metal powder as presently claimed.

Consequently, it is submitted that the present article claims are distinguished over the teachings of the Mita et al patent.

It is submitted that the Yoshimura et al publication does not supply the teaching deficiencies of the Mita et al patent. The Yoshimura et al publication is directed to a R-Fe-B permanent magnet having an electric insulating film allegedly excellent in adhesion, electric insulating properties, corrosion resistance, and heat resistance. The Yoshimura et al publication further discloses a base metallic film provided on the surface of the magnet, followed by a chromate treatment/film provided on the base metallic film, followed by a silane coupling agent and lastly a polyimide film provided on the outermost surface of the permanent magnet. The base metallic film apparently has a thickness of 1.0  $\mu\text{m}$  to 10  $\mu\text{m}$ .

Among other things, the Yoshimura et al publication does not teach or suggest a film layer made of a fine metal powder formed on a metal surface of the magnet. Further, the Yoshimura et al publication does not teach or suggest a film layer made of a fine metal powder of particles having a longest diameter in a range of 0.001  $\mu\text{m}$  to 5  $\mu\text{m}$ .

For the reasons stated above, withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of independent claims 1 and 17, as amended, and the claims dependent thereon over the cited patent publications are respectfully requested.

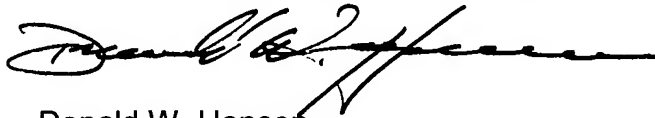
Serial Number: 10/068,970  
OA Dated May 25, 2005  
Amdt. dated October 25, 2005

In view of the foregoing, it is submitted that the subject application is now in condition for allowance and early notice to that effect is earnestly solicited.

In the event this paper is not timely filed, the undersigned hereby petitions for an appropriate extension of time. The fee for this extension may be charged to Deposit Account No. 01-2340, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

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